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09/801,687	03/09/2001	Seppo Reino Keronen	169.1469CIPII	3242

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EXAMINER

FUREMAN, JARED

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/801,687

Applicant(s)

KERONEN ET AL.

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Receipt is acknowledged of the IDS filed on 9/16/2002, which has been entered in the file. A reference on the IDS has been lined through, since no copy of this reference was provided, the reference will be considered upon receipt of a copy. The parent application 09/414,558, including art cited therein, has been reviewed. Claims 1-21 are pending.

### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

a. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/414,558, filed 10/8/1999. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced should be included.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing

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date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

***Specification***

2. The abstract of the disclosure is objected to because the abstract contains the legal phraseology "said". All instances of "said" should be removed from the abstract. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

3. Claims 7 and 13-17 are objected to because of the following informalities:

Claim 7, line 3: "the" (second occurrence) should be replaced with --a--, in order to avoid a lack of proper antecedent basis for "the network".

Claim 13, line 3: the extra period at the end of line 3 should be deleted.

Claims 14-17, line 3: --the-- should be inserted before "user", in order to clarify the claims.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5, 6, 8-11, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al (US 6,249,644 B1) in view of Patton (US 5,845,160).

Inoue et al teaches a virtual image album system comprising: a card (an index print) comprising a substrate, indicia (the images on the index print) formed on the substrate, the indicia being representative of image data (the images on the index print

are representative of image data on the film cartridge 52 or optical disk 53), a reader (remote control 19) for the card, the reader comprising a touch sensitive membrane (transparent touch panel 19a) arranged to overlay the card and through which the indicia are visible (see figure 3), the reader being adapted to output specific function data associated with a user selected one of the indicia (the remote control is used to identify the specific frame selected by the user) to a external device (film player 51 and/or album apparatus 54), thereby to reference specific said image data (the selected frame is used to identify which image should be read and displayed on the monitor 55) , an image store (film cartridge 52 or optical disk 53 and associated reading means) adapted to receive the specific function data, and to output the specific image data in response thereto, a user display (monitor 55) adapted to receive the specific image data from the image store and further display the specific image data, the image data comprises still-image data (the images are still photos), the indicia comprise thumbnail images (see figure 3) each representative of a corresponding still-image, the image store is a CD-ROM (optical disk 53) located in proximity to the user, and the specific image data is provided to the user display via a local data connection (connections between the album apparatus 54, the film player 51 and the monitor 55), a service providing device (film player 51, album apparatus 54) for a virtual image album system including a processor (processors 5, 11, system controllers 21, 35) for storing digital images that were digitized from photographic film (film cartridge 52) in an image store (optical disk 53) and storing function data to access the image store, wherein the function data is a command and memory address to read a specific image data from an

image store (film cartridge 52 or optical disk 53) that is located in proximity to the user (see figures 1, 3, 8-10, column 1 line 8-12, column 4 lines 44-60, column 5 lines 52-54, column 7 lines 39-49, and column 8 lines 36-42).

Inoue et al fails to specifically teach the card substrate having a memory device associated therewith, function data stored within the memory device and associated with the image data, the reader device including a connector to connect to the interface card and a processor for reading the function data associated with the indicia, a processor for storing function data to access the image store into a memory device in a control card.

Patton teaches a card (14) comprising a substrate having a memory device (data storage unit 20 and/or bar code identification number 44a) associated therewith, indicia (imagettes 18) formed on the substrate, the indicia being representative of image data (the imagettes represent image files 16a stored in image file set 16), and function data (the bar code identification number 44a contains data to match the imagettes to the image files 16a in the image file set 16) stored within the memory device and associated with the image data, a reader device (input unit 32) including a connector (interface 26 and/or read element 46) to connect to the interface card and a processor (not shown, but necessary for reading/interpreting data from the interface 26 and read element 46) for reading the function data associated with the indicia and outputting the function data to a external device (controller 50) to refer specific image data, a processor for storing function data to access the image store into a memory device in a control card (the system as taught by Patton necessarily includes a processor to store data in the data

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storage unit 20 and/or to transform the data into an identification number 44a form) (see figures 1, 2, 4, column 1 line 52 - column 2 line 7, column 2 line 43 - column 4 line 21, column 5 lines 1-32, column 7 lines 5-20, and column 9 lines 12-45).

In view of Patton's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Inoue et al, the card substrate having a memory device associated therewith, function data stored within the memory device and associated with the image data, the reader device including a connector to connect to the interface card and a processor for reading the function data associated with the indicia, a processor for storing function data to access the image store into a memory device in a control card, in order to provide a means for automatically associating the card with specific image data, thereby simplifying the use of multiple cards with the system.

6. Claims 3, 4, 7, and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al as modified by Patton in view of Munyan (US 5,761,485).

The teachings of Inoue et al as modified by Patton have been discussed above.

Inoue et al as modified by Patton fails to specifically teach the image data comprises video image data, the thumbnail images being representative of a corresponding video sequence, the image store being located remotely from the user, and the specific image data is down-loaded to the user display over a network in accordance with the user selected one of the indicia, wherein the function data is a command and memory address to down-load the specific image data to a user display over a network from an image store that is located remotely from the user.



Munyan teaches a virtual image album system including, image data comprising video image data (video clips or animation sequences), displaying thumbnail images (icons 101) each representative of a still-image (photographs, for example) or a corresponding video sequence (a video clip, for example), and downloading specific image data corresponding to the thumbnail images to a user display (display screen 20 or 30) over a network (telephone lines 9, for example) in accordance with a user selected one of the indicia, wherein the system includes function data (data/commands associated with icons 101) that is a command and memory address to download the specific image data (image data corresponding to icons 101) to a user display (20, 30) over a network (9) from an image store (database storage devices 16) that is located remotely from the user (see figures 1, 3, column 1 lines 5-15, column 4 lines 63-67, column 5 lines 66 - column 6 line 58, column 7 lines 16-58, column 8 line 66 - column 9 line 4, column 10 lines 63-67, column 11 lines 57-62, column 12 lines 43-49, column 14 lines 26-32, and column 15 lines 47-60).

In view of Munyan's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Inoue et al as modified by Patton, the image data comprises video image data, the thumbnail images being representative of a corresponding video sequence, the image store being located remotely from the user, and the specific image data is down-loaded to the user display over a network in accordance with the user selected one of the indicia, wherein the function data is a command and memory address to down-load the specific image data to a user display over a network from an image store that is located remotely from

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the user, in order to provide a greater variety of images/video image data available to the user, thereby increasing the versatility of the system.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patton et al (US 6,408,301 B1), Manico et al (US 6,072,980), Mankovitz (US 5,949,492), Kono (US 5,914,707), Bell et al (US 5,878,292), Inoue (JP 8-129236 A), and Oshima (JP 8-294080 A) all teach virtual image album systems. Haneda (US 5,461,222) teaches a memory card (20) having indicia thereon (not shown) and reader (tablet 10) having transparent touch sensitive membrane (15) overlaying the indicia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

*Jared J. Fureman*  
Jared J. Fureman  
April 12, 2003